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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,037	12/10/1999	MASASHI HAMADA	1232-4604	9614

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EXAMINER

DAVIS, TEMICA M

ART UNIT	PAPER NUMBER
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2681

DATE MAILED: 05/19/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/459,037

**Applicant(s)**

HAMADA ET AL.

**Examiner**

Temica M. Davis

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 25-27, 41-43, 47-52 and 57-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 25-27, 41-43, 47-52, 57-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed April 22, 2004 have been fully considered but they are not persuasive.

Applicant argues that Steijer fails to disclose receiving data (i.e., tariff information) during a registration sequence. The examiner, however, disagrees. Steijer discloses a cellular system that allows a mobile communication device to store and calculate tariff information for use in determining how much a call is going to be based on the time of day the call is made and based on where the mobile communication device is located during a communication (col. 1, lines 46-62 and col. 3, lines 35-47).

Steijer further discloses wherein this tariff information is sent to the communication device during a registration sequence as evidenced by the fact that the information is sent to the communications device at or before call set up. The examiner is interpreting the call set up as part of a registration sequence. It is known in the art that a call cannot be set up for a communication device unless it has registered with the system. Thus in its broadest interpretation, call set up can be considered part of a registration sequence.

Applicant also argues that Steijer taken alone or in combination with Reece fails to disclose storing a communication charge for a first carrier in accordance with switching from the first carrier to the second carrier. The examiner, however, disagrees. Steijer is used to show that tariff information can change based on the location in which

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a communication device is in (col. 1, lines 38-45). Steijer is silent as to if the change from one location area to another location area involves changing from first and second carriers. Reece does disclose that a mobile device moving through a cellular system can switch from a first carrier to a second carrier. The mobile device is informed of the cost of the call of the second carrier it has switched to (col. 3, line 59-col. 4, line 47, col. 6, lines 21-43, col. 15, line 30-col. 16, line 37; figures 7, 10 and 11).

Based on the above remarks, Steijer taken alone and in reasonable combination with Reece, meets the limitations of the invention as presently claimed. The rejections are set forth below.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 25-27, 41-43, 47-52 and 57-62 are rejected under 35 U.S.C. 102(e) as being anticipated by Steijer, U.S. Patent No. 6,408,174.

Regarding claim 25, Steijer discloses a radio communication apparatus comprising receiving means for receiving data related to charge and time from a communication network (i.e., tariff information) during a registration sequence (i.e., at or

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before call set-up) (col. 3, lines 35-67); and storing means for storing a communication charge in accordance with the data received from the communication network in a registration sequence (i.e., at or before call set-up) (col. 3, lines 35-67), and for storing communication start time in accordance with the data received from the communication network (col. 4, lines 3-60; figures 2A-4).

Regarding claim 26, Steijer discloses a method for storing a communication charge, comprising the steps of receiving data related to charge and time from a communication network during a registration sequence (i.e., at or before call set-up) (col. 3, lines 35-67); storing a communication charge in accordance with the data received from the communication network in a registration sequence (col. 3, lines 35-67); and storing communication start time in accordance with the data received from the communication network (col. 4, lines 3-60; figures 2A-figure 4).

Regarding claim 27, Steijer discloses a memory for storing a program comprising the steps of: receiving data related to charge and time from a communication network during a registration sequence (i.e., at or before call set-up) (col. 3, lines 35-67); storing a communication charge in accordance with the data received from the communication network in a registration sequence (col. 3, lines 35-67); and storing communication start time in accordance with the data received from the communication network (col. 4, lines 3-60).

Regarding claim 41, Steijer discloses the apparatus according to claim 25, wherein the communication charge and the communication start time is stored in accordance with the data received from the communication network after an inherent

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authentication process in a registration sequence (since the mobile station can't communicate in a network until it has been authorized to do so) (col. 3, line 61-col. 4, line 60).

Regarding claim 42, Steijer discloses the method according to claim 26, wherein the communication charge and the communication start time is stored in accordance with the data received from the communication network after an authentication process in a registration sequence (col. 3, line 61-col. 4, line 60).

Regarding claim 43, Steijer discloses the memory according to the claim 27, wherein the communication charge and the communication start time is stored in accordance with the data received from the communication network after an authentication process in a registration sequence (col. 3, line 61-col. 4, line 60).

Regarding claim 47, Steijer discloses a radio communication apparatus comprising receiving means for receiving data related to time from a communication network during a registration sequence (i.e., at or before call set-up) (col. 3, lines 35-67); and storing means for storing communication start time in accordance with the data received from the communication network in a registration sequence (col. 3, line 61-col. 4, line 60).

Regarding claim 48, Steijer discloses the apparatus according to claim 47, wherein said storing means stores the communication start time in accordance with the data received from the communication network after an authentication process in a registration sequence (col. 3, line 61-col. 4, line 60).

Regarding claim 49, Steijer discloses a method for storing time, comprising the steps of receiving data related to time from a communication network during a registration sequence (i.e., at or before call set-up) (col. 3, lines 35-67); storing communication start time in accordance with the data received from the communication network in a registration sequence (col. 3, line 61-col. 4, line 60).

Regarding claim 50, Steijer discloses the method according to claim 49, wherein the communication start time is stored in accordance with the data received from the communication network after an authentication process in a registration sequence (col. 3, line 61-col. 4, line 60).

Regarding claim 51, Steijer discloses a memory for storing a program comprising the steps of: receiving data related to time from a communication network during a registration sequence (i.e., at or before call set-up) (col. 3, lines 35-67); and storing communication start time in accordance with the data received from the communication network in a registration sequence (col. 3, line 61-col. 4, line 60).

Regarding claim 52, Steijer discloses the memory according to claim 51, wherein the communication start time is stored in accordance with the data received from the communication network after an authentication process in a registration sequence (col. 3, line 61-col. 4, line 60).

Regarding claim 57, Steijer discloses a radio communication apparatus comprising: receiving means for receiving data related to time from a communication network during a registration sequence (i.e., at or before call set-up) (col. 3, lines 35-67); and storing means for storing communication end time (i.e., call release/tariff

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switching) in accordance with the data received from the communication network in a registration sequence (col. 1, lines 45-62) col. 3, line 61-col. 4, line 60; figures 2A and 2B).

Regarding claim 58, Steijer discloses the apparatus according to claim 57, wherein said storing means stores the communication end time in accordance with the data received from the communication network after an authentication process in a registration sequence (col. 3, line 61-col. 4, line 60).

Regarding claim 59, Steijer discloses a method for storing time, comprising the steps of receiving data related to time from a communication network during a registration sequence (i.e., at or before call set-up) (col. 3, lines 35-67); and storing communication end time in accordance with the data received from the communication network in a registration sequence (col. 1, lines 45-62, col. 3, line 61-col. 4, line 60).

Regarding claim 60, Steijer discloses the method according to claim 59, wherein the communication end time is stored in accordance with the data received from the communication network after an authentication process in a registration sequence (col. 3, line 61-col. 4, line 60).

Regarding claim 61, Steijer discloses a memory for storing a program comprising the steps of: receiving data related to time from a communication network during a registration sequence (i.e., at or before call set-up) (col. 3, lines 35-67); and storing communication end time in accordance with the data received from the communication network in a registration sequence (col. 1, lines 45-62, col. 3, line 61-col. 4, line 60).



Regarding claim 62, Steijer discloses the memory according to claim 61, wherein the communication end time is stored in accordance with the data received from the communication network after an authentication process in a registration sequence (col. 3, line 61-col. 4, line 60).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 63-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steijer in view of Reece et al (Reece), U.S. Patent No. 5,915,214.

Regarding claims 63 and 65, Steijer discloses an apparatus/method comprising inherent switching means for switching from a first tariff charge to a second tariff charge during a communication as evidenced by the fact that a tariff switch takes place (col. 4, lines 3-60) and storing a communication charge for the first tariff charge in accordance with the tariff change during communication (col. 3, line 54-67). Steijer also discloses wherein tariff information is switched based on the location of the mobile station in a geographical area (col. 1, lines 38-52, col. 3, lines 35-47 and col. 4, lines 3-53).

Steijer, however fails to specifically disclose wherein the switching and storing of the tariff information is related to a switch from a first carrier to a second carrier.

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In a similar field of endeavor, Reece discloses a mobile communication service provider selection system. Reece further discloses that during a communication of a mobile station, the mobile station can switch from a first carrier to a second carrier and know the associated cost of each carrier (col. 3, line 59-col. 4, line 47, col. 6, lines 21-43, col. 15, line 30-col. 16, line 37; figures 7, 10 and 11).

At the time of invention, it would have been obvious to a person of ordinary skill in the art to modify Steijer with the teachings of Reece for the purpose of allowing the mobile station to know when it has roamed into a coverage area of a different service provider having a different cost for current communication.

Regarding claims 64 and 66, the combination of Steijer and Reece discloses the apparatus according to claims 63 and 65, wherein said storing means/step stores communication start time for the second carrier (Steijer, col. 3, line 58-col. 4, line 60; figure 4).

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Temica M. Davis whose telephone number is (703) 306-5837. The examiner can normally be reached Monday-Friday (alternate Fridays) from 9:00am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika Gary can be reached on (703) 308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Temica M. Davis  
Examiner  
Art Unit 2681

May 14, 2004



**TEMICA M. DAVIS**  
**PATENT EXAMINER**